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Byung Ju Dan

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LEE, HONG, DEGERMAN, KANG & SCHMADEKA  
660 S. FIGUEROA STREET  
Suite 2300  
LOS ANGELES, CA 90017

EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/931,349	<b>Applicant(s)</b> DAN ET AL.	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/2008 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the physical growth of the toy (claims 35 and 42) and the toy growing in size (Claim 38) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 35, 38, and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Regarding claims 35, 38, and 42,** while it is easy to see how a virtual character could grow, it is unclear as to how the toy can physically grow and this lacks an enabling explanation. It appears that applicant is attempting to claim physical growth, and while the specification recites the term "physically" when referring to growth, the specification does not have any description of how this growth could occur. In fact, the

specification recites the toy as being intellectually grown (storing more information) as well. Thus, Examiner interprets the word “physically” to refer to visual growth of a virtual character as opposed to the intellectual growth, which is not visual. Since a virtual pet could “physically” grow, as in the virtual body of the pet “physically” growing in size on the display screen, and in light of the lack of enablement, Examiner interprets the toy growing in size (as recited in claim 38) to refer to the visual growth of the virtual character, and not to the growing of the outer casing of the toy. A fair reading of the specification does not support physical growth of the structure of the toy itself. Claims 36-41 inherit this rejection through dependency from claim 35.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**4. Claims 35-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 35**, this claim recites the limitation “a signal interpretable as the toy requesting a certain input”. The term “interpretable” is unclear. If one user is unable to interpret a signal while another user can, is the signal really “interpretable”? Examiner suggests the language “a signal representing a request for a certain input” and it is believed that the specification would support such an amendment. Claims 36-41 inherit this rejection through dependency from claim 35.

**Regarding claims 35 and 42**, these claims recite the limitation “the toy grows either intellectually or physically”. Dictionary.com (Unabridged Volume 1.1) defines “intellectual” as “possessing or showing intellect or mental capacity”. Dictionary.com defines “mental” as “of or pertaining to the mind”. Dictionary.com defines “mind” as “(in a human or other conscious being) the element, part, substance, or process that reasons, thinks, feels, wills, perceives, judges, etc”. It is unclear as to how a non-living non-conscious toy can grow “intellectually”. Intellectual is a term (defined by a dictionary, and thus known to those skilled in the art by the definition) that is used to refer to living subject matter. The toy, however, does not appear to be living subject matter. Examiner interprets “intellectual growth” of the toy as the toy storing more information. Claims 36-41 inherit this rejection through dependency from claim 35.

**Regarding claims 35 and 42**, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. Both claims 35 and 38 recite a toy having a first unit, a microcontroller, and a storage medium. There are also numerous wherein clauses which recite method steps. The structure and the method steps represent product and process in the same claim, which is indefinite. Claims 36-41 inherit this rejection through dependency from claim 35. Please reference MPEP 2173.05(p) II for the basis of this rejection.

**Regarding claims 35 and 42**, these claims recite the limitation “the toy grows either intellectually or physically”. Both of these claims are apparatus claims directed towards a toy. The structure claimed is “a first unit”, “a microcontroller”, and “a storage medium”. There is no structure currently in the claim language that would support

physical growth of the toy. That is, the first unit does not appear to have structure that would allow it to cause the toy to grow. The same goes for the microcontroller and the storage medium. Claims 36-41 inherit this rejection through dependency from claim 35.

**Regarding claims 35 and 42**, these claims recite the limitation “in response to a user selecting an advertisement”. Both of these claims are apparatus claims directed towards a toy. The structure claimed is “a first unit”, “a microcontroller”, and “a storage medium”. There is no structure currently in the claim language that would support receiving an input from a user. That is, the first unit does not appear to have structure (such as a keyboard, buttons, or mouse) that would allow for input from a user. The same goes for the microcontroller and the storage medium. Is there intended to be some sort of input device for a user? Claims 36-41 inherit this rejection through dependency from claim 35.

**Regarding claim 36**, this claim recites the limitation “the advertisement is a banner ad”. Claim 35, from which claim 36 depends, is an apparatus claim reciting “a first unit”, “a microcontroller”, and “a storage medium”. For an apparatus claim, structure is supposed to be claimed, and structure is supposed to be limited by dependent claims. It is unclear as to what structure is implied by a banner ad, and it is unclear as to what structure is being limited by this claim.

**Regarding claim 38**, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. Claim 35, from which 38 depends, recites a toy having a first unit, a microcontroller, and a storage medium. Claim 38 recites a wherein clause which recites

a method step. The structure and the method steps represent product and process in the same claim, which is indefinite. Please reference MPEP 2173.05(p) II for the basis of this rejection.

**Regarding claim 38**, this claim recites the limitation “wherein in response to the information being stored in the storage medium the toy grows in size”. Claim 35, from which claim 38 depends, is an apparatus claim reciting “a first unit”, “a microcontroller”, and “a storage medium”. For an apparatus claim, structure is supposed to be claimed, and structure is supposed to be limited by dependent claims. It is unclear as to what structure is implied by the step of growing in size, and it is unclear as to what structure is being limited by this claim.

**Regarding claim 39**, this claim recites the limitation “associated with signals generated by a living organism”. What signals are generated by living organisms? A signal, albeit one generated by a living organism, is an abstract idea. Further, living organism is not defined by the specification, nor is a signal that is supposed to be generated by a living organism. Examiner is unable to understand what the proper scope of the claim is intended to be.

**Regarding claim 39**, this claim recites the limitation “wherein the first unit outputs information associated with signals generated by a living organism”. Is the user the intended “living organism”? Does this claim imply that the toy monitors the user’s “signals” so that the first unit may output information associated with those signals? Further, the structure claimed in claim 35 (from which 39 depends) is “a first unit”, “a microcontroller”, and “a storage medium”. There is no structure currently in the claim



language that would support monitoring of a living organism. That is, the first unit does not appear to have structure that would allow it to monitor a living organism. The same goes for the microcontroller and the storage medium. Further, the specification is silent to any such monitoring device.

**Regarding claim 41**, this claim recites the limitation “downloading goods or services information comprises inputting name or barcode of real goods directly into the toy using at least one of a CCD camera or a barcode reader”. Neither a camera or a barcode reader represent a data network. Claim 35, from which claim 41 depends, recites the limitation “the data interface is configured to connect to a data network to download goods or services information”. Claim limitations in parent claims can't be altered, only further limited. Claim 35 requires a data network. Claim 41 limits this to a CCD camera or a barcode reader, neither of which represent a data network.

**Regarding claim 41**, this claim recites the limitation “downloading goods or services information comprises inputting name or barcode of real goods directly into the toy using at least one of a CCD camera or a barcode reader”. Claim 35, from which claim 41 depends, is an apparatus claim reciting “a first unit”, “a microcontroller”, and “a storage medium”. For an apparatus claim, structure is supposed to be claimed, and structure is supposed to be limited by dependent claims. It is unclear as to what structure is implied by the step of downloading goods or services information, and it is unclear as to what structure is being limited by this claim. There is no CCD camera or barcode reader actively claimed in the structure of the device.

**Regarding claim 42**, this claim recites the limitation "an animated feature for generating expressions". What structure is being claimed for the apparatus? Is a "feature" supposed to be structural? Is it merely a display? Is it neither? Further, "animated feature" is not defined by the specification. Examiner is unable to understand what the proper scope of the claim is intended to be.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 35-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Ng (U.S. Patent No. 5,971,855).** Ng teaches an apparatus that comprises all of the structural limitations recited in the above claims.

**Regarding claims 35-42**, the following portions of the MPEP are deemed to be relevant to the rejection of the claims:

MPEP 2114 states:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "**recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus**" if the prior art apparatus teaches all the structural limitations of the claim.

MPEP 2106 (II) (C) states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. **Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim**

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**limitation.** The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “**wherein**” clauses, or
- (D) “whereby” clauses.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. **Limitations appearing in the specification but not recited in the claim should not be read into the claim.**

Ng teaches a toy (Column 2, Lines 4-6) with an animated feature (Figure 1a, References 17 and 18), a first unit that sends a signal interpretable as the toy requesting a certain input (Column 7, Lines 34-38), a microcontroller for processing information inputted to the toy by way of a data interface (Figure 5, Reference 506 and Figure 1B, Reference 25 and 26), and a storage medium (Claim 1). The data interface is configured to connect to the Internet to download service information from a game website (a game website is a webpage that promotes the game, and is thus considered an advertising entity website) (Column 2 Lines 38-41 and 51-56, Column 3 Lines 59-63, and Column 4 Lines 1-4).

Further elements taught by Ng that are recited in the claim language, yet according to the MPEP are not required (due to the use of wherein clauses and intended use method steps) include: downloading of information through the data interface that satisfies the signal output from the first unit and "intellectually growing" the toy (Column 2 Lines 38-41 and 51-56, Column 3 Lines 59-63, and Column 4 Lines 1-4).

A banner advertisement is not required by the claim language as it is introduced in a wherein clause method step, and thus, is not actively claimed.

The toy growing in size is not required by the claim language as it is introduced in a wherein clause method step, and thus, is not actively claimed.

A CCD camera is not required by the claim language as it is introduced in a wherein clause method step, and thus, is not actively claimed.

A barcode reader is not required by the claim language as it is introduced in a wherein clause method step, and thus, is not actively claimed.

### ***Response to Arguments***

6. **Applicant argues** “In support of the Applicants' position that the inventor was in the possession of the claimed subject matter (i.e., a toy with movable or growing limbs), the Examiner is referred to page 2, line 2 of the application as filed, wherein the Applicants disclose a "Robo-Dog" which is irrefutably a toy with limbs that move or grow”. Examiner would like to give the following example for Applicant's consideration: The character Robocop is a fictional character identified as half man and half machine. In the 1987 movie of the same name, Robocop was represented as a moving robot. However, in the 1988 video game release "Robocop", the title character was displayed as a virtual character. This example is supplied to show Applicant that the name “Robo-dog” is not irrefutably a toy with limbs that moves or grows. There is no description in the specification stating that a "Robo-dog" has limbs, or that it can grow. Examiner considers a Robo-dog, much like the video game version of Robocop, to merely be a virtual character as well. A fair reading of the specification does not support physical growth of the structure of the toy itself.

7. **Applicant argues** “There is no portion in the specification that either explicitly or implicitly limits the invention to a virtual toy (i.e., a toy displayed on a screen)”. If

Applicant contends that the specification has no support for virtual growth, and Examiner has deemed that a fair reading of the specification does not support physical growth of the structure of the toy itself, then there exists the possibility that Applicant's invention can not be fully understood from the specification as originally filed. If the toy does not physically grow (as the specification shows no support for this), and a virtual character displayed by the toy does not virtually grow (as insinuated by Applicant), then how does "growth" occur?

8. **Applicant argues** "referring to FIG. 5, a motor 100-1 is disclosed which supports a mechanical instrument within the toy that may be used to move or grow a limb. As such, the Examiner's argument that the egg-shaped drawing in FIG. 11 should be interpreted narrowly to exclude any physical growth in the toy, and to limit it to a virtual character on a screen, is counter intuitive to the nature and spirit of the disclosure". Applicant's argument says that there is a motor that "may be" used to move or grow a limb. The fact remains, however, that the uses of this "motor" is never described. A conventional motor might power a lawn mower. Does this mean (much like structural growth) that Applicant's specification also has support for the toy having the ability to cut grass? The egg-shaped drawing in Figure 11 is simply that, egg-shaped. How would this egg grow? There is no indication from the drawing that the egg changes size in any way. While the rectangular box on the egg is not clearly labeled as a display screen, this portion could be considered a display screen in which a virtual character could be displayed. Once again, a fair reading of the specification does not support physical growth of the structure of the toy itself. However, Applicant's argument brings up

another point. If the toy is being claimed to physically grow, Figure 11 (or some other Figure) should show this feature. Currently, there is no drawing to support this, which is why Examiner has added an objection to the drawings above.

9. Examiner has reviewed Applicant's specification multiple times and has found absolutely nothing that would irrefutably suggest that Applicant had structural growth of the toy at the time of the filing of the invention. Quite the opposite, Examiner contends that Figures 10-12, the only figures that actually show the toy, teach away from structural growth as these figures merely display an egg-shaped toy with no mechanical instruments that could extend. The egg has four lines coming from it with circles at the ends of those lines, however to call these "limbs" would be a stretch. In fact, there are no reference numbers to indicate what these circles and lines represent, or even if they are meant to be part of the toy itself. Examiner has seen nothing in the specification as a whole up to this point that would change the opinion that no structural growth is present.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMANN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/  
Examiner, Art Unit 3622